

REMARKS

Claims 1-28 are pending in this application. Claims 1 and 15 are independent.

35 U.S.C. §112

The examiner has rejected claims 1, 3-6, 8-11, and 15-28 under 35 U.S.C. §112 as being indefinite due to the phrase “securities processing system.” The applicants have amended claims 1, 3, 4-6, 8-11, 15, 17-20, and 22-25 and therefore, the objections should be withdrawn.

35 U.S.C. § 101

The examiner has rejected claims 1-28 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. However, the examiner suggested “amending the claims to include some form of technology, such as a computer, etc. in the body of the claim.” In order to promote prosecution, the applicants have amended independent claims 1 and 15 to more particularly recite that the invention is a new and useful process that promotes the technological arts. In particular, as amended, independent claims 1 and 15 include: “storing, on a computer readable medium, the identified one or more assessment issues in an issue and resolution log... storing, on a computer readable medium, the process and technology performance information... [and] storing, on a computer readable medium, the information regarding the abilities of at least one system external to the securities processing system to apply straight through processing to securities transactions.” The applicants believe that these amendments will overcome the examiner’s rejection and that independent claims 1 and 15 should now be patentable.

Furthermore, as the examiner cited, 35 U.S.C. §101 defines statutory subject matter as “any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof.” For a claim to be statutory under 35 U.S.C. §101, the process must produce a “useful, concrete, tangible” result (*see State Street Bank & Trust Co. v. Signature*

Financial Group, Inc., 149 F.3d1368, 1374-75, 47 USPQ 2d 1596, 1602 (Fed. Cir. 1998); *see also USPTO presentation titled U.S.C. 101 Training Materials slides 9-12*).

Claims 1-28 indeed produce a "useful, concrete, tangible" result and are therefore statutory under 35 U.S.C. §101. For example, claims 1 and 15 include "developing an implementation plan." The implementation plan is a useful, concrete, and tangible result.


Dependent claims 2-14 and 16-28 should be patentable for at least the same reasons as the independent claims on which they depend. The applicants have also amended claims 5, 6, 9-13, 19, 20, 21, 24, and 27. With each of these amendments, no new matter has been added.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any charges or credits to deposit account 06-1050, reference 12587-064001

Respectfully submitted,

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